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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,535	06/29/2001	James S. Magdych	NAIIP009/01.114.01	6510
28875	7590	03/21/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			AILES, BENJAMIN A	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,535

Applicant(s)

MAGDYCH ET AL.

Examiner

Benjamin A Ailes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in regards to the Amendment and Request for Reconsideration received on 22 December 2004. This action is NON-FINAL. Claims 1-25 are pending in this application.

Response to Amendment

2. Examiner acknowledges the amendment to claims 8-14 and 23, which are now in conformance. Rejection has been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 25, the specification does not disclose "an e-mail vulnerability module with a predetermined port of 31337, and a Trojan program vulnerability module with a predetermined port of 25.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 24 recites the limitation "all 65,536 ports" in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3-8, 10-15, and 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Fudge (U.S. 6,205,552), hereinafter referred to as Fudge.

10. Regarding claims 1, 8, 15, 22, and 23, Fudge teaches a risk assessment scan, comprising:

- Selecting a plurality of risk-assessment modules... (Fig. 1, part 160, col. 2, lines 58-63, and col. 3, lines 48-55);
- Determining a first set of ports... (col. 3, lines 39-44 and col. 3, line 64 – col. 4, line 41);
- Executing a port scan... (col. 2, lines 22-27 and 34-36);

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- Determining a second set of ports based on the port scan... (col. 3, lines 35-39);
and,
- Disabling the risk-assessment modules... (col. 3, lines 35-39 and 51-55).

11. Regarding claims 3, 10, and 17, in accordance with claims 1, 8, and 15, respectively, Fudge teaches the method wherein the modules are user-specified (col. 3, lines 30-33).

12. Regarding claims 4, 11, and 18, in accordance with claims 1, 8, and 15, respectively, Fudge teaches the method further comprising storing a third set of ports including the first set of ports and excluding the second set of ports (col. 3, lines 34-39)

13. Regarding claims 5, 12, and 19, in accordance with claims 4, 11, and 18, respectively, Fudge teaches the method further comprising comparing the port associated with each risk-assessment module with the stored third set of ports (col. 3, lines 39-44).

14. Regarding claims 6, 13, and 20, in accordance with claims 5, 12, and 19, respectively, Fudge teaches the method further comprising performing the vulnerability checks of the risk-assessment module if the port associated with the risk-assessment module matches at least one port of the stored third set of ports (col. 3, lines 48-55).

15. Regarding claims 7, 14, and 21, in accordance with claims 5, 12, and 19, respectively, Fudge teaches the method wherein the risk-assessment module is disabled if the port associated with the risk-assessment module does not match at least one port of the stored third set of ports (col. 4, lines 25-31).

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16. Regarding claim 24, in accordance with claim 1, Fudge teaches the method wherein a port scan involving all 65,536 ports is avoided (col. 2, lines 31-40).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 2, 9, and 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fudge in view of Choi (U.S. 5,734,824), hereinafter referred to as Choi.

19. Regarding claims 2, 9, and 16, Fudge discloses the method of associating risk-assessment modules with ports (col. 2, lines 58-63), but is silent on the elimination of port redundancy. However in related prior art, Choi discloses a method for eliminating redundant communication ports (Choi, col. 8, lines 59-65). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the port redundancy elimination method as disclosed by Choi in combination with the risk-assessment method disclosed by Fudge. One would have been motivated to make such a combination in order to significantly reduce the time and cost involved in scanning for vulnerable devices in a network (see Fudge, col. 2, lines 20-23).

Response to Arguments

20. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Because new grounds of rejection are being applied against substantively unamended claims, this action is NON-FINAL.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes, whose telephone number is (571)272-3899. The examiner can normally be reached on Monday-Friday (7:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached at (571)272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703)872-3906.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

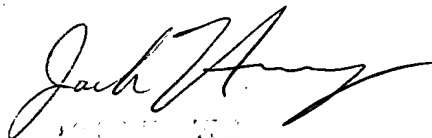
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [benjamin.ailes@uspto.gov].

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All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Benjamin Ailes
Patent Examiner
Art Unit 2142



JACK H. AILES
SUPERVISOR, ART UNIT 2142